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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/780,638	02/19/2004	Ming Bo Wang	021565-156	2125
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EXAMINER				
KALLIS, RUSSELL				
ART UNIT		PAPER NUMBER		
1638				
NOTIFICATION DATE		DELIVERY MODE		
11/30/2009		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ADIPFDD@bipc.com

Office Action Summary

Application No.

10/780,638

Applicant(s)

WANG ET AL.

Examiner

RUSSELL KALLIS

Art Unit

1638

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 August 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/CD)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-12 are pending and examined.

Claim Rejections - 35 USC § 103

Claims 1-12 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Wesley S. *et al.* The Plant Journal, 2001; Vol. 27, no. 6; pp. 581-590 in view of Yukawa Y. *et al.* Plant Molecular Biology, 2002; Vol. 50, pp. 713-723 and Applicant's specification. This rejection is maintained for the reasons of record set forth in the Official action mailed 1/25/2007, 10/22/2007 and 2/24/2009. Applicant's arguments filed 8/24/2009 have been considered but are not deemed persuasive.

Applicant asserts on page 2 of the response that Yukawa is limited to, or only teaches *in vitro* expression using Pol III promoters and provides no evidence regarding how well chimeric genes comprising a Pol III promoter will actually be expressed *in vivo* in plant tissues. Contrary to Applicants' assertion, Yukawa does teach the usefulness of the Pol III promoters for *in vivo* expression in transformed plants (See Abstract). Further, the evidence provided by Yukawa does bear upon how useful the promoter regions of the genes used in Yukawa's experiments would be in expressing heterologous genes in transformed plants. For example, the insertion of foreign genetic material into the 7SL coding region did not have a negative effect upon transcription strongly suggesting that the promoter elements were 5' of the coding region and that the transcripts were stable for a long period of time.

In response to Applicants' assertion on page 3 of the response that Yukawa does not demonstrate that the 7SL POL III promoter can be used to transcribe antisense and ribozyme sequences, Applicants attention is directed to Figure 1 where the chimeric constructs expressed in the experiments of Yukawa clearly show antisense features.

Applicant asserts that the prior art has failed to appreciate the efficiency of Pol III promoters taught by Yukawa relative to the Pol II type promoters such as CaMV35S and that there would have been no reason to expect Pol III promoters to perform better than Pol II promoters (response page 5). This argument is not well founded because the prior art did appreciate that the Pol III genes comprise strong promoters that are ubiquitously synthesized in all kinds of tissues (see Yukawa page 720 discussion beginning in col 1 to end of Col. 2). Clearly, Yukawa advocated Pol III promoters as an attractive vehicles for the expression of antisense and ribozymes and that the 7SL POL III promoter is a type III promoter (see Yukawa page 720 discussion columns 1-2 and page 714 1st column 2nd full paragraph). Moreover, in response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., greater transcription and hence enhanced suppression of gene expression using Pol III relative to Pol II promoters, or any specific level of transcription comparatively speaking) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

\Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

No claim is allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Russell Kallis whose telephone number is (571) 272-0798. The examiner can normally be reached on M-F 8:30-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anne Marie Grunberg can be reached on (571) 272-0975. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Russell Kallis/
Primary Examiner, Art Unit 1638
November 20, 2009